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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,501	05/10/2001	Michael Bleser	29488/36831A	6411

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/852,501

Applicant(s)

BLESER ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). . .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 10. 6) ☐ Other: .

### DETAILED ACTION

1. Applicant's arguments are moot in view of the new grounds of rejection.
2. Applicant is requested to resubmit a copy of the IDS filed 9/16/03 as the filed copy cannot be found.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al (US Patent No. 6,473,500)..

As per claims 1, 7, 12, 14 and 17, Risafi et al disclose a system and method for selling a giftcard at a store location of a first retailer for use at a second retailer (see column 5, lines 17), the method comprising:

Displaying a plurality of non-activated giftcards in the store location of the first retailer (column 10, lines 32-51; column 16, lines 11-33 and column 18, lines 43-59);

Activating a selected one of the displayed giftcards upon receipt of a purchase amount from a customer (column 10, lines 32-51; column 16, lines 11-33 and column 18, lines 43-59);

Forwarding information pertaining to the selected giftcard to a processor associated with the second retailer (column 16, lines 11-33) (the TELCO is a second retailer);

Transferring proceeds from the first retailer to the second retailer, the proceeds including at least a portion of the purchase amount (column 16, lines 11-30; column 11, line 58 to column 12, lines 19).

An activation record is maintained by the PDC. Note column 13, lines 54-63; column 8, lines 15-21 and column 7, lines 30-43.

As per claims 2 and 8, Risafi et al disclose calculating a revenue share of the purchase amount for the first retailer. See column 11, lines 58-64 and column 9, lines 44-50.

As per claims 3 and 9, the giftcard has a preset credit value. Note column 9, lines 42-46 and column 10, lines 33-38.

As per claim 4, the giftcards are displayed at the first retailer, each set of giftcards being redeemable at a different second retailer. See column 16, lines 11-15; column 17, line 65 to column 18, line 3 of Risafi et al.

As per claim 5, the processor is provided by the second retailer (which is the TELCO processor), see column 16, lines 11-33 of Risafi et al.

As per claim 6, the processor is provided by a third party associated with the second retailer which is the PDC (see column 16, lines 11-33 and column 10, lines 44-49).

As per claim 10, the claimed “plurality of second retailers comprises an outside retailer consortium” is read as a plurality of merchants where goods and services are sold/provided. See column 17, line 65 to column 18, line 3 of Risafi et al. The claimed “and in which the processor

is provided by the outside retailers consortium” is read as the processors of the second retailers or the TELCO. Note also column 16, lines 11-33 of Risafi et al.

As per claim 11, the claimed “plurality of second retailers comprises an outside retailer consortium” is read as a plurality of merchants where goods and services are sold/provided. See column 17, line 65 to column 18, line 3 of Risafi et al. The claimed “and in which the processor is provided by a third party associated with the outside retailers retailer” is read as the PDC. Note also column 16, lines 11-33 and column 10, lines 44-49 of Risafi et al.

As per claim 13, the first retailer comprises a first retail chain, and wherein the second and different retailer comprises a second retail chain. Note column 17, line 65 to column 17, line 3 and column 10, lines 51-54 of Risafi et al.

As per claim 15, the activation record is accessible by the third party. See column 13, lines 54-63; column 8, lines 15-21 and column 7, lines 30-43.

As per claim 16, the giftcard is provided by the first retailer, see column 18, lines 44-60 and column 16, lines 11-33 of Risafi et al.

As per claim 18, the giftcard is associated with at least one store location of a plurality of additional and different retailers, the processor accessible by the plurality of additional and different retailers, and wherein the portion of the purchase amount is available for transfer from the first retailer to a selected one of the plurality of additional and different retailers. (column 16, lines 11-30; column 11, line 58 to column 12, lines 19).

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-18 do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-18 are rejected as being directed to non-statutory subject matter.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) (872-9327).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP  
December 3, 2003

*Frantzy Poinvil*  
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443628